

REMARKS

Claim rejections under 35 USC 112, first paragraph

Claims 1-7 have been rejected under 35 USC 112, first paragraph, due to lack of enablement. In particular, the Examiner has stated that, as to the limitation of claim 1 regarding “a plurality of predetermined people other than the customer,” it is unclear how the customer can be excluded from the predetermined people in the database in view of the specification. Applicant respectfully disagrees, and very respectfully submits that it is crucial to understand this limitation vis-à-vis the specification to understand the scope of this embodiment of the invention.

In the embodiment of the invention covered by claim 1, the idea is that the “biometric information of the customer is compared against a database of biometric information of people other than the customer, to yield one or more people having biometric information that most closely matches biometric information of the customer.” (Specification, p. 4, ll. 14-17) “Importantly, the database preferably does not include biometric information of the customer him or herself.” (Id., p. 4, ll. 19-22) “This is because the goal is not identification of the customer – i.e., determining the customer’s identity – but rather for amusement and entertainment to indicate to the customer other people that have similar biometric information as that of the customer.” (Id., p. 4, l. 22, through p. 5, l. 2)

Thus, as is clear from the patent application as filed, the idea in claim 1 is that you can get your biometric information scanned – e.g., such as your face (Specification, p. 4, ll. 19-21) – and then see what other people are similar to you biometrically, such as other people that look like you, for amusement purposes. “People may be interested to learn, for example, what sports stars their faces most closely resemble, or the movie stars who have hand geometries most similar to them.” (Id., p. 2, ll. 6-8) The people in the database “are preferably famous individuals, such as sports stars, celebrities, politicians, and historical figures.” (Id., p. 5, ll. 3-4) “Furthermore, the people may be fictitious persons or characters, such as popular cartoon characters.” (Id., p. 5,

ll. 4-5) “The intention in one embodiment of the invention is to have biometric of people with which typical customers are likely to be familiar.” (Id., p. 5, ll. 5-7) As such, “the customer can learn whom he or she ‘looks like’ or ‘sounds like,’ as determined biometrically.” (Id., p. 5, ll. 9-10)

Therefore, the exclusion of the customer from the plurality of predetermined people gets to the heart of this embodiment of the invention. For amusement and entertainment, a customer learns who he or she resembles from this plurality of predetermined people. Obviously, the customer most resembles him or herself – and this is one reason why he or she is not included in the plurality of predetermined people. The point is that these are predetermined people who the customer is likely to be familiar with. A customer can find out, for instance, that he looks like Brad Pitt, or that she sounds like Diana Ross. The patent application as filed most definitively enables the predetermined people not including the customer him or herself, since this is the whole point of this embodiment of the invention. Therefore, Applicant submits that claim 1, and claims 2-7 that depend therefrom, are enabled by the specification as filed.

Claim rejections under 35 USC 112, second paragraph

Claims 2, 3, 6, 7, 14, 18, and 19 have been rejected under 35 USC 112, second paragraph, as being indefinite. As to claims 2 and 14, the Examiner has stated that the phrase “other eye scans” is indefinite. Without prejudice, Applicant has removed this phrase from these claims. As to claim 3, the Examiner has stated that the limitation “the group of databases” lacks antecedent basis. Without prejudice, Applicant has removed this limitation from this claim. As to claims 6 and 7, the Examiner has stated that the limitation “the identifies” lacks antecedent basis. Without prejudice, Applicant has corrected this limitation to correctly read “the identities.”

As to claims 18 and 19, the Examiner has stated that there is insufficient antecedent basis for the limitation “the first” in line 6 of claim 18 and in lines 2 and 5 of claim 19. Applicant does not necessarily agree. These phrases read “the first and the second customers,” where “a first

customer” and “a second customer” were earlier introduced, and to which the phrase “the first and the second customers” relate back. However, as a gesture of good faith, Applicant has amended these phrases to instead read “the first customer and the second customer,” and submits that the Examiner should find the amended phrases acceptable under 35 USC 112.

Claim rejections under 35 USC 102 as to Ort

Claims 1, 2, and 4-6 have been rejected under 35 USC 102(b) as being anticipated by Ort (5,659,626). Claim 1 is an independent claim, from which claims 2 and 4-6 ultimately depend. Applicant submits that Ort does not anticipate at least claim 1 as has been amended, such that claims 2 and 4-6 are patentable due to their dependence from a patentable independent claim.

Claim 1 has been amended as follows. First, it has been made clear that it is an “entertainment machine” that detects biometric information of a customer, compares this information against a database of people other than the customer, and indicates *to the customer* who he or she most closely resembles performs these steps, acts, or parts. Furthermore, these people are those *other than the customer* and “with which the customer is likely to be familiar.” (See specification, p. 5, ll. 3-12)

Ort does not teach, disclose, or suggest any of these claim limitations. First, Ort does not teach anything in relation to “an entertainment machine.” Rather, Orton states that:

This invention relates to an improved fingerprint identification system. Fingerprints are routinely used to identify individuals of unknown or uncertain identity, or to verify the identity of a person. A primary application is in law enforcement and secondary applications are in security, credit, and entitlement program management.

(Col. 1, ll. 10-16) Law enforcement, security, credit, and entitlement programs are most definitively not related to an entertainment machine.

Second, Ort does not disclose matching the biometric information of a customer against “a database of biometric information of a plurality of predetermined people *other than the customer*,” as to which the claimed invention is limited. The Examiner has stated that column 1,

lines 57-61 of Ort discloses matching the customer against a plurality of predetermined people other than the customer. However, this excerpt of Ort simply states that “a third type of search, latent-to-latent, is made when trying to determine if the same unknown person was present at two or more scene[s] of crime locations.” As such, you are comparing biometric information at a first crime scene against biometric information at a second crime scene, to see if these biometric information come from the same person – i.e., if the same person committed both crimes. It cannot be stated, then, that the database of biometric information is *inherently* of predetermined people *other than the customer*, since the whole goal is to see if the criminal at the first crime scene is the same person as the criminal at the second crime scene. That is, *inherently*, the database of biometric information against which the first crime scene biometric information is compared ideally includes this same biometric information. Otherwise, there is no point in comparing the biometric information at these two crime scenes – if it is known a priori, for instance, that the same person did not commit both crimes.

Third, Ort does not disclose matching the biometric information of a customer against “a database of biometric information of a plurality of predetermined people . . . *with which the customer is likely to be familiar*,” as to which the claimed invention is limited. As has been noted, the purpose of Ort is “an improved fingerprint identification system.” (Col. 1, ll. 11-12) A law enforcement user may compare fingerprints of a person against a database of fingerprints to learn the identity of that person, such that it is not inherent that this *person* (not the law enforcement user) is familiar with the people having the fingerprints in the database. As to security, credit, and entitlement program management users, such users may compare fingerprints of a person against a database of fingerprints or against known fingerprints of the user to determine who that person is, or to verify that the person is who he or she claims to be. As such, it is not inherent that this *person* (not the security, credit, or entitlement program management user) is familiar with the people having the fingerprints in the database.

Finally, Ort does not disclose “indicating *to the customer* identities of the one or more people having biometric information that most closely matches the biometric information *of the customer*,” as to which the claimed invention is limited. The Examiner has stated that column 2, lines 5-15 of Ort disclose this aspect of the claimed invention. However, this excerpt merely states the following:

When a fingerprint database becomes large, it becomes unmanageable to use human experts to perform the searching operation, therefore the need for automated systems. Automated systems . . . examine the images and extract and store features that describe the finger; they also store any supporting alphanumeric textual information appearing on ten-print cards or with the latents, the textual data is that which would be of benefit in performing comparisons.

This excerpt does not disclose indicating *to the customer* the identities of people having biometric information that most closely matches the biometric information *of the customer*. Again, let us look at the purpose of Ort, as relating “to an improved fingerprint identification system,” where such fingerprints “are routinely use to identify individuals of unknown or uncertain identity, or to verify that identity of a person,” where applications includes “law enforcement . . . security, credit, and entitlement program management.” It is important to note that in the claimed invention, the customer has his or her biometric information detected, and that it is this same customer to whom the identities of people having similar biometric information are indicated. This is not what you do in typical fingerprint identification situations. For example, if you have fingerprints of an unknown person, a user may be a police or security officer who is trying to determine the identity of the person. The closest matches are indicated to this user, *not to the unknown person him or herself*, in contradistinction to the claimed invention. Likewise, if you are a user who is presenting your fingerprint for authentication purposes, the system does not say “by the way, your fingerprints are just like those of Bob in Accounting”; rather, the system says that you are who you claim to be, or you are not who you claim to be. In either situation, therefore, Ort does not indicate to the customer whose biometric information was detected what other people have similar biometric information.

For all of these reasons, therefore, Ort does not anticipate the claimed invention.

Claim rejections under 35 USC 102 as to Howard

Claims 1-8, 10-18, and 20 have been rejected under 35 USC 102(e) as being anticipated by Howard (2004/0133582). Without prejudice, claim 20 has been cancelled. Claims 1, 8, 13, and 18 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant submits that claims 1, 8, 13, and 18 do not anticipate claims 1, 8, 13, and 18 as have been amended, such that the other claims rejected on this basis are also patentable due to their dependence from a patentable independent claim. It is noted that there is substantial correspondence between the method of claim 1 and the entertainment machine of claim 8 as to the present rejection over Howard, such that claims 1 and 8 are discussed together. Likewise, there is substantial correspondence between the method of claim 13 and the entertainment machine of claim 18 as to the present rejection over Howard, such that claims 13 and 18 are discussed together.

Claims 1 and 8

Claims 1 and 8 are limited to “an entertainment machine” that obtains biometric information of a customer. This entertainment machine then compares this biometric information against a database of biometric information of predetermined people “with which the customer is likely to be familiar” to yield people having biometric information that mostly closely matches the biometric information of the customer. The entertainment machine indicates these people to the customer.

The most relevant embodiment of Howard to the claimed invention of claims 1 and 8 is described in Howard as follows:

We even anticipate that the method of FIG. 6 can be used to implement functionality as disparate as computer dating, searching for models and/or actors, and law enforcement searching. For example, in a computer dating or model/actor search implementation, an individual may be desirous of finding a person in the

database who “looks like” their ideal (which ideal may be an image resembling, for example, an ex-girlfriend or boyfriend, a celebrity or model, an idealized image created by the individual, an image that closely resembles the individual himself or herself, etc.)

(Para. [0148]) Let us parse this embodiment of Howard. As has been discussed above in relation to Ort, law enforcement searching is not relevant to entertainment, such that Howard’s law enforcement searching embodiment cannot anticipate an invention that is directly limited to “an entertainment machine.” Finding a model or an actor, or computer dating, however, in the most general reading of Howard may be encompassed by an “entertainment machine.” Presumably, in either situation, a user can find a model or an actor that “looks like” himself or herself, or a potential dating partner that “looks like” himself or herself, consistent with the claimed invention.

However, the claimed invention is limited to comparing the biometric information of the customer to a database of biometric information of predetermined people “with which the customer is likely to be familiar.” It is this limitation that is not explicitly or inherently disclosed in Howard. In first instance, Howard makes no explicit reference to whether the people against which the customer is being compared are people that the customer is familiar with. Explicitly, therefore, Howard does not anticipate this aspect of the claimed invention.

Let us look at implicit or inherent disclosure of this aspect of the claimed invention in Howard, however. As the legal standard governing this discussion, Applicant notes that “[i]nherency, however, may *not* be established by probabilities or *possibilities*. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” (Continental Can Co. USA v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)) Rather, the extrinsic evidence “must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference.” (*Id.*)

First, with respect to computer dating, as can be appreciated by those of ordinary skill within the art and presumably by the Examiner, the idea of computer dating is that you get to learn of potential dating partners that you did not know before. That is, if you knew all the

potential dating partners already, then there would be no point to paying for the computer dating service. (For example, consider the online dating service www.match.com, which enables subscribers to “find great dates.”) Therefore, it is no inherent that the customer is likely to be familiar with the people against which his or her biometric information is being compared. In fact, the opposite is in greater likelihood to be true – that the people in the database are people that the customer is not likely to be familiar with, since the customer is paying to find a date with someone, and if the customer already knew all the people in the database, he or she would not have to use the computer dating service. Therefore, this limitation is not “necessarily present” within Howard.

Second with respect to model or actor searching, Howard is silent as to how or why this model or actor searching is to be achieved. There is the scenario envisioned by the claimed invention, in which a user wants to find models or actors that he or she is likely to be familiar with. However, just as likely is another type of model or actor searching. Consider this example: I am a director of a movie, and want a new actor who looks like myself (or who looks like Brad Pitt, Diana Ross, etc.) to play a part in the movie. I do not want to star in the movie myself, and I do not want to pay the high price that Brad Pitt, Diana Ross, or another star *with whom I am familiar* to star in the movie. Therefore, I use Howard’s biometric searching to find someone *who I do not know already* and who looks like me, Brad Pitt, Diana Ross, or whatever. The idea here, then, is that such a director would be searching among predetermined people with whom *he or she is not likely to be familiar* – in contradistinction to the claimed invention. Insofar Howard is silent as to how or why model or actor searching is to be performed, this situation is just as likely (if not more so) than the claimed invention, such that the aspect of the claimed invention in question is not “necessarily present” in Howard. As a result, Howard does inherently anticipate this limitation of the claimed invention.

Claims 13 and 18

Claims 13 and 18 are limited to “an entertainment machine” that obtains biometric information of *two customers*, determines how closely they are to one another, and indicates *to these customers* this measurement of how closely their biometric information is. Importantly, in other words, the claimed invention is limited to indicating how closely two customers’ biometric information match *to these two customers*. For example, the value of such an entertainment machine can be in two people who are dating one another or who are married learning for amusement purposes how closely they look alike, how much they sound alike, and so on. The claimed invention has been amended to specify that the second customer is different than the first customer. (See, e.g., specification, p. 8, ll. 19-23, in which prizes and awards may be provided for the first and the second customers in accordance with how closely “they” match one another, such that the closest match to date of “two” customers may cause “them” to receive an award – the words “they,” “them,” and “two” indicate the first and the second customers are not the same person.)

The most relevant portion of Howard to the embodiments of the claimed invention covered by claims 13 and 18 is in paragraph [0022], which reads as follows:

Commercial manufacturers . . . manufacture biometric recognition systems that can be adapted to be capable of comparing two images. For example, the IDENTIX FACE IT product may be used to compare two facial images *to determine whether the two images belong to the same person*. Other commercial products are available that can compare two fingerprint images and *determine whether the two images belong to the same person*.

Howard thus diverges from the claimed invention in at least two significant ways. First, the claimed invention obtains biometric information of a first customer, and then obtains biometric information of a second customer. The second customer is different than the first customer. However, in Howard, you are comparing two images to see if they belong to the same person. As such, it is not *inherent* in Howard that the first person is different than the second person. In fact, there is at least some likelihood that these two people are the same person; otherwise, there is no

point in comparing two images to see if they belong to the same person. Therefore, this aspect of the claimed invention is not anticipated by Howard.

Second, Howard does not disclose indicating how closely the biometric information of the first and the second customers match one another *to these customers themselves*. That is, in the claimed invention, the entertainment machine indicates *to the first and the second customers* how close their biometric information is. Howard is silent as to this point, and thus cannot explicitly anticipate this aspect of the claimed invention. However, Howard also does not implicitly anticipate this aspect of the claimed invention, either. For example, as has been described above, the usefulness of determining whether two images are of the same person is useful when you are looking at two sets of fingerprints from different crime scenes. In this instance, how closely the two images match is not going to be indicated *to the people whose faces or fingerprints are in the images*, but rather to a law enforcement or a security user. Therefore, the aspect of the claimed invention in question is not “necessarily present” within Howard, such that the claimed invention is not anticipated by Howard.

Claim rejections under 35 USC 103

Claims 9 and 19 have been rejected under 35 USC 103(a) as being unpatentable over Howard in view of Walker (6,110,041). Claims 9 and 19 are dependent claims, depending from one of the independent claims discussed above. Therefore, claims 9 and 19 are patentable at least because their base independent claims are patentable.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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